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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,966

06/29/2005

Kenneth Andrew Hughes

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6105

7590

06/29/2006

Linda D Birch
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Legal Patent
Wilmington, DE 19805

EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/540,966	Applicant(s) HUGHES ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) 4-7 and 9-14 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 8 and 15-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

Claims 1–3, 8 and 15-18 are under consideration in this application.

Claims 4-7 and 9-14 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on June 9, 2006 is acknowledged. The traversal is on the ground(s) all the claims ultimately depend from claim 1. This is not found persuasive because for the reasons clearly set forth in the previous Office action. Further, applicants have failed to advance any cogent reasons as to why there is unity of invention.

It is too burdensome for the examiner to search all of the previously noted searches in their respective, completely divergent, areas for the non-elected subject matter, as well, in the limited time provided to search one invention.

The requirement is still deemed proper and is therefore maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1625

Claims 1-3, 8 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Lahm et al. (US 2005/0075372) and Berger et al. (US 2004/0209923).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Lahm et al. and Berger et al. specifically disclose the instant compound wherein R^3 is Cl, R^7 is H, R^2 is CF_3 , R^4 is iso-propyl and R^5 is H. Note example 6 of Berger et al. or compound 779 of Lahm et al. Hence, the instant compound is deemed to be anticipated therefrom.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 1625

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 8 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Lahm et al. and Berger et al.

Lahm et al. and Berger et al generically embrace the instant compounds. Note, for example, the compounds of formula (I) of Lahm et al. or Berger et al. wherein R⁴ is CN.

It is believed that one having ordinary skill in the art would have found the claimed compounds prima facie obvious, since they are generically embraced by the disclosed formula; In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See also In re Malagari, 499 F.2 1297, 182 USPQ 549 (CCPA 1974); In re Lemin, 332 F.2d 839, 141 USPQ 814 (CCPA 1964); In re Rosicky, 276 F.2d 656, 125 USPQ 341 (CCPA 1960). The requisite motivation for arriving at the claimed compounds stems from the fact that they fall within the generic class of compounds disclosed by Lahm et al. I-III. Accordingly, one having ordinary skill in the art would have been motivated to prepare any of the compounds embraced by the disclosed generic formula, including those encompassed by the claims, with the expectation that each of them would be suitable as pesticidies.

It is believed well settled that a reference may be relied upon for all that it would have reasonably conveyed to one having ordinary skill in the art. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); In re Lamberti, 545 F.2d 747, 192 USPQ 278 (CCPA 1976); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Susi, supra.

Further, the instant ompounds differs from the specific prior art compound as halogen analogs and alkyl homologs. For example, the instant compounds wherein R³ is F or Br are

Art Unit: 1625

halogen analogs or the instant compounds wherein R⁴ is ethyl, n-propyl or butyl are alkyl homologs of example 6 of Berger et al. or compound no. 779 of Lahm et al. One having ordinary skill in the art would have been motivated by the disclosure of the prior art compound to arrive at other compounds within the claimed genus as well as at the claimed species. The motivation to make these compounds is their close structural similarities to the disclosed compound. Note that the disclosed compound has insecticidal activity, thus the skilled artisan would expect such structurally similar compounds to possess similar properties. While homology is considered to be present even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. Attention, in this regard is directed to *In re Druey et al.*, 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

that in "We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants the term homologue is used by chemists at times in a broad sense, and at other times a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

Also, as the Court stated in *In re Payne et al.*, 606 F.2d 302, 203 USPQ 245 at 255 (CCPA 1979):

"the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound."

In addition, any question of why would one conceive and use the similar compounds (i.e. "motivation") is answered by the Court in *In re Gyurik et al.*, 596 F.2d 1012, 201 USPQ 552 at 557.

"In obviousness rejections based in close similarity in chemical structure, the

Art Unit: 1625

necessary motivation to make a claimed compound, and thus the prima facie case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the treatment of insects and worms, does not reasonably provide enablement for the treatment of all invertebrate pests. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

No enablement is shown for the treatment of pests such as bacteria, fungi, bacteria, etc.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 1625

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 17 of copending Application No. 10/483,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds are disclosed therein having the same use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 8 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 24 of copending Application No. 10/485,125. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant compounds are disclosed having the same use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Conclusion

No claim is allowed.

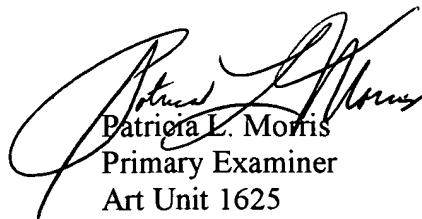
Art Unit: 1625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688.

The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
June 27, 2006